IN THE ABSTRACT

The abstract has been provided on a separate sheet as requested by the Examiner and is attached behind this Amendment.

REMARKS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Rejections Under 103(a)

Examiner has rejected claims 109-136 under 35 USC 103(a) as being unpatentable over Lauffer, U.S. Patent No. 6,223,165 B1 (hereinafter referred to as "Lauffer").

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examing Procedure (MPEP) ¶ 2143.03).

The examiner has agreed that the Lauffer reference does not disclose the claimed limitation, or a limitation similar thereto as included in the independent claims, of a controller computer using a customer's selection of a service provider to initiate a process of establishing a telephonic connection between a service provider and a customer, ***wherein the process of establishing the telephonic connection includes at***

least subsequently prompting the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list.

However, the examiner has stated that it would be obvious to modify the Lauffer reference to include the claimed limitation. For the following reasons, Applicants respectfully disagree.

The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills,* 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so. *In re Mills,* 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

The Lauffer reference has not been identified to suggest the desirability of the modification to include the claimed limitation of a controller computer using a customer's selection of a service provider to initiate a process of establishing a telephonic connection between a service provider and a customer, ***wherein the process of establishing the telephonic connection includes at least subsequently prompting the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list.***

In addition, a statement that modifications of the prior art to meet the claimed invention would have " 'well within the ordinary skill of the art at the time claimed invention was made' " because the references relied upon teach that all aspect of the claimed invention were individually kwon in the art is not sufficient to establish a *prima*

facie case of obviousness without some objective reason to combine or modify the teachings of the reference. *Ex Parte Levengood,* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab,* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). (MPEP 2143.01).

Once again, there is not objective reasoning to combine or modify the Lauffer reference, as suggested, to include the claimed limitation of a controller computer using a customer's selection of a service provider to initiate a process of establishing a telephonic connection between a service provider and a customer, ***wherein the process of establishing the telephonic connection includes at least subsequently prompting the customer as to whether the customer wants to establish the telephonic connection with the service provider from the list.***

Therefore, considering modification of the Lauffer reference is not obvious in accordance with the stated legal principles stated above, applicant's independent claims are patentable over the Lauffer reference. Furthermore, the remaining dependent claims, by way of being dependent on the independent claims, include the distinguishing claim limitations discussed above, and are therefore also patentable over the Lauffer reference.

Double Patenting Rejections

Examiner has rejected claims 109-136 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of Lauffer in view of Official Notice, as discussed in the art rejection above.

Examiner has provisionally rejected claims 109-136 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-147 of copending Application No. 09/733,872 in view of Official Notice.

Examiner has provisionally rejected claims 109-136 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-141 of copending Application No. 09/782,925 in view of Official Notice.

Examiner has provisionally rejected claims 109-136 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-137 of copending Application No. 09/782,984 in view of Official Notice.

A terminal disclaimer is submitted herein to overcome the double patenting rejections.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: February 3, 2003

John P. Ward
Reg. No. 40,216

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300